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--18. (amended) The apparatus of claim 14 wherein the reference feature identifier includes a controller adapted to (a) move the main sensor in a predetermined pattern surrounding the expected coordinate region of the reference features, and (b) stop the movement of the main sensor when the reference features are located within the field of view of the main sensor.

## Remarks

The Office Action has been carefully reviewed and this Response prepared in view of the Examiner's comments in the Action. The Applicants appreciate the attention of the Examiner to the application.

The drawings have been herein amended to show the controller 50 as requested in the Office Action. No new matter has been entered. The specification has been amended to reflect the drawing amendments. In response to the claim objections in the Office Action, the specification has been further amended to include the required phrase "The invention claimed is:"

Various rejections under 35 USC 112, second paragraph, have been overcome by amending the claims to avoid objected to phrases, indefinite language, narrative/operative language and terms lacking positive antecedent basis. It is believed that all 35 USC 112 issues have been remedied by the amendments herein.

Claims 14-15 and 18 have been rejected under 35 USC 102(b) as being anticipated by Chaiken et al. (U.S. Patent No. 5,333,111). Claims 16 and 17 has been rejected under 35 USC 103(a) as being unpatentable over Chaiken et al.

Multiple phrases in claims 14-18 were not considered because they were asserted to be "intended use" statements which did not define any specific structure. MPEP 2173.05(g) provides that functional limitations must be evaluated and considered, just like any other claim limitation, for what they fairly convey to a person of ordinary skill in the art in the context in which they are used. *In re Venezia*, 189 USPQ 149 (CCPA 1976), held that a limitation such as "members adapted to be positioned" serves to precisely define present structural attributes of interrelated component parts of the claimed assembly. Therefore, the previously non-considered phrases are herein amended to comply with *Venezia* and more clearly require

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structural requirements which are not disclosed or suggested by the cited prior art. For instance, the following claim elements comply with *Venezia* and are not disclosed or suggested by Chaiken et al:

- a "reference feature identifier adapted to automatically determine a coordinate region of the reference features if the reference features are not in an expected coordinate region on the sheet-receiving surface, and adapted to sense metrics of the reference features in order to infer the approximate positions of the registration marks when the coordinate region of the reference features is known." (Claim 14).
- a "controller adapted to (a) enlarge a field of view of the main sensor by zooming
  the lens, (b) locate the reference features within the enlarged field of view, (c)
  reposition the main sensor in response to the locating step, and (d) shrink the field
  of view of the main sensor by zooming the lens such that the reference features are
  within the field of view of the main sensor." (Claim 15).
- a "controller adapted to (a) enlarge the field of view of the main sensor by
  increasing the distance of the main sensor from the sheet of material, (b) locate the
  reference features within the enlarged field of view, (c) reposition the main sensor in
  response to the locating step, and (d) shrink the field of view of the main sensor by
  decreasing the distance of the main sensor from the sheet of material such that the
  reference features are within the field of view of the main sensor," (Claim 16).
- a "controller adapted to (a) locate the reference features within a field of view of the secondary sensor, and (b) reposition the main sensor in response to locating the reference features within the field of view of the secondary sensor such that the reference features are within the field of view of the main sensor." (Claim 17).
- a "controller adapted to (a) move the main sensor in a predetermined pattern surrounding the expected coordinate region of the reference features, and (b) stop the movement of the main sensor when the reference features are located within the field of view of the main sensor." (Claim 18).

Therefore, the Applicants believe that all rejections have been traversed by amendment and argument and all claims are in proper form for allowance. Early favorable action is earnestly



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solicited. The Examiner is invited to call the undersigned attorney if that would be helpful in facilitating resolution of any issues which might remain.

It is believed that no fee is due with respect to this response; however, if a fee is due please debit Deposit Account 10-0270 and inform the undersigned.

Respectfully submitted,

James P. Delaney

Registration No. 45,57

Dated: October 17, 2002

Jansson, Shupe & Munger, Ltd. 245 Main Street Racine, WI 53403-1034 Attorney Docket No. MG-105US

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Gudi Marish 10-17-02 Signature Date

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